

REMARKS

Claims 36-43 are pending. By this Amendment, no claims are cancelled, claims 36-39 and 42 are amended, and new claim 44 is added. No new matter is introduced by the amendments.

In view of the following comments, Applicants respectfully request favorable consideration and allowance of claims 36-44.

Claim Objections

The Examiner objected to the claim 39 for depending from itself. Applicants thank the Examiner for a careful reading of the claims. Applicants have amended claim 39 to depend from claim 38 and respectfully request withdrawal of the objection.

Claims Rejected Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 36-43 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter that Applicants regard as the invention. While Applicants do not acquiesce in the Examiner's assertion, Applicants have amended the claims and respectfully request withdrawal of the 35 U.S.C. § 112, second paragraph rejection.

Claim Rejections Under 35 U.S.C. § 102 Over Weissman

Claims 36 and 37 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,602,674 to Weissman et al. ("Weissman"). To advance prosecution of the application, Applicants have amended claim 36 to more particularly point out their claimed invention. For the reasons discussed below, Weissman does not *prima facie* anticipate claims 36 or 37. Accordingly, Applicants respectfully request reconsideration of the rejection.

Weissman does not anticipate independent claim 36, as amended, as the reference does not teach or suggest enabling selection of a desired objective for viewing said microscope slide and determination if said desired objective corresponds to a magnification of one of said one or more previously-captured images, and wherein if said desired objective corresponds to a magnification of one of said one or more previously-captured images, displaying said one of said one or more previously-captured images on a screen, and wherein if said desired objective does not correspond to a magnification of one of said one or more previously-captured images, obtaining a real-time image of microscope slide at said desired magnification and presenting said real-time image on said screen.

Therefore, because Weissman does not teach all of the features of claim 36, Weissman does not anticipate Applicants' claimed invention. Applicants do not comment further on issues relating to dependent claim 37, although Applicants do not acquiesce in the Examiner's assertions regarding this claim. Applicants respectfully request the withdrawal of the rejection.

Claim Rejections Under 35 U.S.C. § 102 Over Kamentsky

Claims 36 and 37 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,793,969 to Kamentsky et al. ("Kamentsky"). For the reasons discussed below, Kamentsky also does not *prima facie* anticipate claims 36 or 37. Accordingly, Applicants respectfully request reconsideration of the rejection.

As with Weissman, Kamentsky does not anticipate independent claim 36, as the reference does not teach or suggest enabling selection of a desired objective for viewing said microscope slide and determination if said desired objective corresponds to a magnification of one of said one or more previously-captured images, and wherein if said desired objective corresponds to a magnification of one of said one or more previously-captured images, displaying said one of said one or more previously-captured images on a screen, and wherein if said desired objective does

not correspond to a magnification of one of said one or more previously-captured images, obtaining a real-time image of microscope slide at said desired magnification and presenting said real-time image on said screen.

Therefore, because Kamentsky does not teach all of the features of claim 36, Kamentsky does not anticipate Applicants' claimed invention. Applicants do not comment further on issues relating to dependent claim 37, although Applicants do not acquiesce in the Examiner's assertions regarding this claim. Applicants respectfully request the withdrawal of the rejection.

Claim Rejections Under 35 U.S.C. § 103 Over Kamentsky and Silverbrook

Claims 36-43 are rejected under 35 U.S.C. § 103(a) as being obvious over Kamentsky in view of U.S. Patent No. 5,329,616 to Silverbrook ("Silverbrook"). As discussed above, Applicants have amended claim 36 to more particularly point out their claimed invention. For the reasons discussed below, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request reconsideration of the rejection.

A *prima facie* case of obviousness of Applicants' claimed invention has not been established, as the cited references do not teach, suggest, or motivate all of the features included in claim 36. "To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art." MPEP 2143.03. Specifically, Silverbrook does not make up for the deficiencies of Kamentsky discussed above with respect to claim 36, from which claims 37-43 depend. As such, the references do not render Applicants' claimed invention *prima facie* obvious. Thus, Applicants respectfully request reconsideration of the rejection of the claims.

Applicants do not comment further here on the suitability of combining or modifying the cited references. Nor do Applicants comment further on issues relating to the dependent claims,

although Applicants do not acquiesce in the Examiner's assertions regarding these claims. Applicants respectfully request the withdrawal of the rejection.

Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Erik M. Drange', followed by a horizontal line.

Erik M. Drange

Registration No. 57,750

Customer No. 24113
Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 252-1538